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TM02/0312

EXAMINER

RETTA, Y

ART UNIT

PAPER NUMBER

2162

DATE MAILED:

03/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/241,083

Applicant(s)

Kosuda et al.

Examiner

Yehdega Retta

Group Art Unit

2162

☒ Responsive to communication(s) filed on Dec 28, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-10 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Response to Amendment

1. This office action is in response to amendment filed December 28, 2000.

Response to Arguments

2. Applicant's arguments filed December 28, 2000 have been fully considered but they are not persuasive.

Applicant's argues that Tognazzini does not provide options for the user to receive a paper receipt and to transmit the receipt to the destination address. As stated below, the claim as recites, the display providing options to transmit or print, is an intended use. There are no steps cited indicating any action performed through the input means. The claim recites destination electronic mail address is able to be input through the input means. As stated below any system including Tognazzini is able, for any information, to be input through the input means. The recited limitation "able to be input through the input means", and for "receiving a transaction record" does not patentably distinguish the claimed system from the prior art. Assuming that the recited action is performed by the input means, than the rejection of "103" stated below applies..

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1, 2 recites "... a destination electronic mail addressis able to be input through the input means". The recited limitation, is able to, make the claim indefinite. It is not clear whether any information is input or not. The claim as understood by the Examiner recites a screen display, the screen display providing options to choose from.

6. Claim 3 recites " wherein said display control means causes....and performs on said display device screen display indicative that an electronic mail address for transmitting a transaction record is able to be registered. The recited limitation, screen display indicative that an electronic mail address is able to be registered, makes the claim indefinite. Again it is not clear whether the address is registered or not. Any system would be able to register any information. Is able to be registered does not mean the action is being performed. Claim 3 also recites "wherein in the event that the electronic mail is registered,...performs a screen display in which it is selectable through said input means...." and "wherein when a selection operation that the transaction record is to be transmitted...". However, the recited limitation, "wherein in the event that the electronic mail is registered... it is selectable", makes the claim indefinite. There is no step that recites that the electronic mail was registered and being able to select through the input means, does not mean

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that a selection is made through the input means. It is not clear whether selection is made through the screen display.

7. Claim 4 is rejected as stated above in claim 3.
8. Claims 5 and 6 are rejected as stated above in claim 2.
9. Claim 7 recites, "an input device enabling the consumer to perform transactions...". Since the claim recites similar limitation as claim 1, the rejection of claim 1 applies.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Tognazzini

U.S. Patent No. 5739512.

12. As per claim 1, Tognazzini disclose a display device; means for controlling the display; performing input operation in accordance with a display on the device (see col. 5 lines 17-28 and fig. 2), performing on the display device a screen display in which a destination electronic mail address for receiving a transaction record is able to be input through the input means and a screen display providing options to the consumer to choose from, the options being to transmit the

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transaction record to the destination address or print the transaction record at the facility (see col. 6 lines 17-25 and fig. 5).

The claim recites "...wherein the display control means performs on said display device a screen display in which a destination electronic mail address for receiving a transaction record of a customer is able to be input...". The claim does not recites transmitting the transaction record, it only recites an intended use, for receiving, a transaction record. It also recites "...providing an option to choose from....., however the claim does not recite the system performing any action of printing or transmitting the receipt. Such limitation does not patentably distinguish the invention from the cited prior art.

13. Regarding claims 7-9, Tognazzini teaches a display device and an input device enabling the customer to perform transaction according to options displayed on the display device and a transaction receipt process displaying options on said display device. The claim recites displaying options to receive..... It does not recite transaction receipt being receive at the destination electronic mail address or received as paper receipt or both. The recited statement of intended use, to receive transaction record, does not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide option to make any selection in the system taught by Tognazzini because the subjective interpretation of the displaying option to selectively receive does not patentably distinguish the claimed invention.

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Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tognazzini U.S. Patent No. 5739512.

16. As per claim 1, Tognazzini teaches a display device; means for controlling the display; performing input operation in accordance with a display on the device (see col. 5 lines 17-28 and fig. 2), performing on the display device a screen display in which a destination electronic mail address for receiving a transaction record is able to be input through the input means and a screen display providing options to the consumer to choose from, the options being to transmit the transaction record to the destination address or print the transaction record at the facility (see col. 6 lines 17-25 and fig. 5). Tognazzini does not teach providing the option to the customer to choose both transmit the receipt to the destination address and print (hard copy) at the facility. However, Tognazzini teaches receiving paper receipt (see background). Tognazzini teaches when the cash register generates a receipt a transmitter sends an electronic copy of the receipt to the electronic mail address. Tognazzini also discloses the electronic copy being digitally signed by the customer before being sent to the electronic mail address or customer's smart card receiving a copy of the digital receipt, process the digital signature and then return the signed receipt to the

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cash register for sending the electronic receipts (see col. 5 lines 32-55). Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention to modify Tognazzini's paper less transaction by including an option to print and transmit the receipt. One would be motivated to have the option to have a paper receipt, which is analogous to the digital receipt of Tognazzini, in order to verify the transaction at the facility, and in case of credit transaction in order to sign the transaction as taught by Tognazzini, and to receive electronic copy through electronic mail in order to use the electronic receipt in case the paper receipt is lost.

17. As per claims 2, 5 and 6, Tognazzini teaches display control means perform on the display device a screen display in which a record being able to be input (see fig. 2). Tognazzini does not teach a number of transaction records inputted. The claim does not recite any action or step of inputting number of transaction records which distinguish the claimed invention from the prior art in terms of patentability. Being able to input is not the same as inputting the record and there is not step being performed after the input is performed which distinguish the claim invention from the prior art in terms of patentability. Any system, including Tognazzini, is able to input a number of transaction records. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to input any data in the display as shown in Tognazzini because inputting different data from the prior art would have been obvious matter of design choice.

18. As per claim 3, Tognazzini teaches a display device; display control means; input means for performing an input operation in accordance with a display and control means for

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communicating with the host computer (see fig. 1); displaying transaction indications including a payment indication, and performs on said display device a screen display indicative of an electronic mail address for transmitting a transaction record is able to be registered, transmitting the input electronic mail address via communication line to host computer so that the electronic mail address is registered in association with transaction information file for customers (see col. 6 lines 26-39 and fig. 4). Tognazzini does not specifically teach performing a screen display in which selection is performed through the input means as to whether the transaction record....when a selection operation that the transaction record is to be transmitted to an electronic mail address....performing a screen display in which a new destination electronic mail address ...is input. Tognazzini teaches performing a screen display in which it is selectable through input means and performing a screen display in which E-mail address is input (see col. 5 lines 1-45). The claim does not recite selection being performed through the input means and no action or step is claimed after selection is made through the input means which distinguish the claimed invention from the prior art in terms of patentability . Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to make selection through the input means in the screen display as shown in Tognazzini because making selection different from the prior art would have been obvious matter of design choice.

19. Claims 7-9, recites similar limitation as claim 1, therefore the rejection of claim 1 applies.

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20. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tognazzini U.S. Patent No. 5739512, in view of Internet banking; How far, how fast?, Marshall, Jeffery, US Banker, v08, n3, p66-68, Mar 1998 (herein after Marshall).

21. Regarding claims 4 and 10, Tognazzini teaches displaying selection options to transmit a transaction receipt to a destination address or print the transaction receipt at the customer transaction facility (see col. 6, lines 17-25 and fig. 5). Tognazzini does not teach providing the option to the customer to choose both transmit the receipt to the destination address and print (hard copy) at the facility. However, Tognazzini teaches receiving paper receipt (see background). Tognazzini teaches when the cash register generates a receipt a transmitter sends an electronic copy of the receipt to the electronic mail address. Tognazzini also discloses the electronic copy being digitally signed by the customer before being sent to the electronic mail address or customer's smart card receiving a copy of the digital receipt, process the digital signature and then return the signed receipt to the cash register for sending the electronic receipts, which is analogous to the print of the receipt. Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention to modify Tognazzini's paper less transaction by including an option to print and transmit the receipt. One would be motivated to have the option to have a paper receipt in order to verify the transaction right a way and in case of credit transaction to sign the transaction and to receive electronic copy through electronic mail in order to use the electronic receipt in case the paper receipt is lost. Tognazzini teaches transmitting the transaction receipt to pre-selected address however does not specifically teach display options to

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transmit the transaction receipt to a different address. Marshall teaches that Web@TM display screen displaying an option for account statements, reports or transaction receipts to be printed online or e-mailed to the customer(see page 1 abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to combine Tognazzini 's pre-selected address and Web@TM's e-mail system by display options to transmit the transaction receipt to a pre-selected destination or to a different address. One would be motivated to send the transaction receipt to different location in order to be able to receive the information at convenient location, such as the office computer, laptop or palm or home computer.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Peters et al. U.S.Patent No. 6164529, self service terminal.

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on Monday-Friday from 7:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)


or:

(703) 308-5397, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Examiner
Yehdega Retta
Art Unit 2162
March 8, 2001


ERIC W. STAMBER
PRIMARY EXAMINER